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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,645	10/31/2000	Rainer Haas	100564-00035	6963

7590

07/02/2002

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EXAMINER

MYERS, CARLA J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 07/02/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,645

Applicant(s)

HAAS ET AL.

Examiner

Carla Myers

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1634

RESTRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121 and 372:

I. Claims 1-17, 19, 21-52, drawn to methods of detecting antibiotic resistance in *Helicobacter*.

II. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Mycobacteria*.

III. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Porphyromaonas gingivalis*.

IV. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Propionibacterium acnes*.

V. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Borrelia burgdorferi*.

VI. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Mycoplasma*.

VII. Claims 1-6, 8-21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Chlamydia*.

VIII. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Tropheryma whippelii*.

IX. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Bartonella*.

Art Unit: 1634

X. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Legionella*.

XI. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Nocardia*.

XII. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, and 48, drawn to methods of detecting antibiotic resistance in *Actinomycetes*.

2. The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons:

Inventions I-XII are drawn to methods for determining antibiotic resistance in distinct microorganisms by detecting distinct sequences of the microorganisms genome. The nucleic acids detected and used as reagents in the methods of Inventions I-XII differ from one another with respect to their structural and functional properties.

3. Claims 1-6, 8-17, 19, 21, 22, 26-41, 43, 48 link(s) each of the stated inventions. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 1-6, 8-17, 19, 21, 22, 26-41, 43 and 48. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking

Art Unit: 1634

claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

4. ***Sequence Election Requirement Applicable to All Groups***

In addition, each invention detailed above reads on patentably distinct inventions drawn to multiple SEQ ID Numbers. The sequences are patentably distinct because they are structurally and functionally unrelated sequences, and a further restriction is applied to each invention. **In response to the restriction requirement, Applicant must further elect a single nucleotide sequence selected from SEQ ID NO: 1-12 and a single specific region (e.g. , a region "corresponding to nucleotide 2032") corresponding to that that single nucleotide sequence.**

It is noted that nucleotide sequences encoding different proteins and/or having distinct nucleotide sequences are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121 and 372. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.14.

5. Because these inventions are distinct for the reasons given above and have acquired a different status in the art as demonstrated by their divergent subject matter and because

Art Unit: 1634

inventions I-XII require different keyword and sequence searches that are not co-extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (703) 308-2199. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703)-308-1152. The fax number for the Technology Center is (703)-305-3014 or (703)-305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Carla Myers

July 1, 2002


CARLA J. MYERS
PRIMARY EXAMINER